

REMARKS/ARGUMENTS

Claims 1-26 are pending in this application. Claims 1 and 15 are independent claims. Claims 1 and 15 have been currently amended.

Claim Rejections – 35 USC § 102

Claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by Nagashige et al. (“Nagashige”, U.S. Patent Number 5,313,588). Applicant respectfully traverses this rejection.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Further, “anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Independent Claim 1, as amended, recites “said each bus operation information structure including both a command and data to be transferred.” This amendment is supported, for example, by “[t]he bus operation information structures 112 include instructions and data with which a sequencer 116 within the SCSI host adapter 104 performs the process (e.g. read data, write data, etc.) requested by the CPU 110” (emphasis added) (Specification, page 1, lines 24-26). Thus, the “bus operation information structure” recited in Claim 1 is more than an instruction (e.g., a write command, a read command, and the like); instead, it includes *both* a command *and* data to be transferred.

In contrast, in rejecting Claim 1, the Patent Office has analogized a command in Nagashige to the “bus operation information structure”, as claimed in Claim 1 (Office Action, page 2). Therefore, Nagashige fails to teach, disclose, or suggest the element of “said each bus operation information structure including both a command and data to be transferred,” as claimed in Claim 1. Accordingly, the rejection should be withdrawn, and Claim 1 should be allowed.

Claim Rejections – 35 USC § 103(a)

Claims 2-3 and 5-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagashige in view of Richardson (“Richardson”, U.S. Patent Number 6,205,506). Claims 4 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagashige and Richardson and further in view of Su et al. (“Su”, U.S. Patent Number 6,047,339). Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagashige in view of Morris et al. (“Morris”, U.S. Patent Number 6,434,650). Claims 10-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagashige and Morris in view of Daniel et al. (“Daniel”, U.S. Patent Number 5,726,985). Claims 12-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagashige and Morris in view of Su. Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagashige and Morris in view of Blumenau (“Blumenau”, U.S. Patent Number 6,263,445). Claim 15 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagashige in view of Su. Claims 16-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagashige and Su in view of Richardson. Claim 20 and 22-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagashige and Su in view of Kang (“Kang”, U.S. Patent Number 6,052,133). Claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagashige, Su, and Kang in view of Blumenau. Claims 25-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagashige, Su, and Kang in view of Daniel. Applicant respectfully traverses these rejections.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (emphasis added) (MPEP § 2143). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. (emphasis added) *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

As indicated in the foregoing *Claim Rejections – 35 USC § 102* section, Nagashige fails to teach, disclose, or suggest the element of “said each bus operation

information structure including both a command and data to be transferred,” as claimed in Claim 1. Furthermore, none of the foregoing references cited by the Patent Office teaches, discloses, or suggests the above-indicated claim element. Thus, independent Claim 1 is nonobvious under 35 U.S.C. § 103.

Claims 2-14 depend from Claim 1 and are therefore nonobvious due to their dependence. Thus, the rejection should be withdrawn, and Claims 2-14 should be allowed.

Independent Claim 15, as amended, recites “each of said bus operation information structures including both a command and data to be transferred.” For the reasons similar to Claim 1, independent Claim 15 is nonobvious under 35 U.S.C. § 103.

Claims 16-26 depend from Claim 15 and are therefore nonobvious due to their dependence. Thus, the rejection should be withdrawn, and Claims 16-26 should be allowed.

CONCLUSION

In light of the foregoing, Applicant respectfully requests that a timely Notice of Allowance be issued in the case.

Respectfully submitted on behalf of
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